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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,444	07/31/2003	Scott R. Carrier	LOT920030006US1	2867

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HOFFMAN WARNICK & D'ALESSANDRO, LLC  
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EXAMINER
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LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

NOTIFICATION DATE	DELIVERY MODE
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04/08/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/632,444	<b>Applicant(s)</b> CARRIER, SCOTT R.	
	<b>Examiner</b> Wen-Tai Lin	<b>Art Unit</b> 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-26 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al. (hereafter "Stern")[U.S. PGPub 20020032740] in view of Bliss et al. [U.S. Pat. No. 6654789].
4. Stern was cited in the previous office action.
5. As to claims 1-2, Stern teaches the invention substantially as claimed including: a method for automatically generating electronic addresses of users [e.g., paragraphs 69-73], comprising:  
  
providing a sequence of address generation scripts, each address generation script including a unique template that defines a structure for an electronic address [e.g., paragraphs 164-169];

determining a valid electronic address for assigning to a user by iterating through the sequence of address generation scripts in order of which address generation script is preferred by an organization to which the user belongs [e.g., paragraph 161; claim 3; i.e., note it is obvious that the predefined common email address formats such as those shown in paragraphs 164-168 may be arranged in an order of preferences wherein the first on the top of the list is the most preferred format, and so forth],

wherein the valid electronic address is determined when one of the address generation scripts produces an electronic address and complies with a predetermined addressing standard [e.g., Fig.3; paragraphs 160-171].

Stern teaches that the address generation is for marketing purposes (i.e., addresses that already exist). Stern does not specifically teach that the electronic addresses are unique, previously unused and are assigned to users.

However, email address generation processes for purpose of assigning a unique email address to a user among Internet email service providers such as hotmail or yahoo's email servers are well known in the art.

It would have been obvious to one of ordinary skill in the art to apply Stern's reverse engineering method for deducing certain preferred email address formats in the process of new email address assignment based on a user's identifier and his/her affiliation because the process systematically creates more memorable email addresses for users who supply associated information [see paragraphs 173-174 for motivation].

Further, Stern teaches validating an email address by actually sending an email to the created email address. Stern does not suggest validating an email address by checking that it is unique within the same domain server without consuming email reception resource of the organization. This is because Stern's original purpose was to create email addresses for marketing purpose, where testing whether the created email addresses would actually reach its intended targets is ultimately important.

However, Bliss teaches a method of creating and validating email addresses by testing its uniqueness within a registered domain [e.g., col.2, lines 40-59]. It would have been obvious to an ordinary skilled artisan who tries to make use of Stern's reverse engineering method to create new email addresses for a company or ISP associated mailboxes would recognize that the so created email addresses must undergo Bliss' uniqueness test (e.g., by comparing with the existing email addresses held in a database) because it is a common sense not to assign a same email address to more than one person.

6. As to claim 3, Stern further teaches that the user data is provided from a repository [e.g., paragraph 69 and claim 5; i.e., a database] and wherein the sequence of address generation scripts are generated by a user [i.e., testing the various email templates (rules) in an execution environment such as Fig.3 is designed by a program developer].

7. As to claim 4, Stern further teaches that the determining step comprises:

generating a first electronic address according to a first one of the sequence of address generation scripts; and testing the first electronic address to determine if the first address is unique [e.g., paragraph 66] and complies with a predetermined addressing standard [e.g., paragraph 171].

8. As to claims 5 and 7, Stern teaches using predetermined addressing standard to form the email addresses. Therefore the resulting addresses are inherently compliant with the intended standard.

Further, Stern teaches resolving duplicate information stored in the database in general. Stern does not specifically teach resolving duplicates by comparing the generated electronic address against those previously created electronic addresses and that the set of previously created electronic addresses are stored in an electronic address repository.

However, resolving duplicates by the aforementioned comparison method is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to test each of Stern generated email addresses by comparing newly generated address against the existing addressed and storing the previously created electronic addresses in an electronic address repository because the former is a popular and efficient approach to achieve uniqueness, while the latter facilitate access of the existing addresses when performing comparison.

9. As to claim 6, Stern further teaches that the set of previously created electronic addresses are stored in a repository with user data corresponding to the user [e.g., claim 18].

10. As to claims 8-26, since the features of these claims can also be found in claims 1-7, they are rejected for the same reasons set forth in the rejection of claims 1- 7 above.

11. Applicant's arguments filed on 9/5/2007 for claims 1-26 have been fully considered but are moot in view of the new ground of rejection.

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

March 27, 2008

/Wen-Tai Lin/

Primary Examiner, Art Unit 2154